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In re Application of
SABANATHAN, Thirumani
Application No.: 09/762,692
PCT No.: PCT/GB98/00652
Int. Filing Date: 03 March 1998
Priority Date: 30 April 1997
Attorney Docket No.: 007-001
For: OCCLUSION DEVICE

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on applicant's "Renewed Petition to Revive under 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 24 November 2003.

BACKGROUND

On 03 March 1998, applicant filed international application no. PCT/GB98/00652 which claimed a priority date of 30 April 1997 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 November 1998.

A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999.

On 09 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee, a copy of the international application, and a petition seeking revival under 37 CFR 1.137(b) with the appropriate fee. The petition was dismissed in a decision dated 24 May 2001 because the delay was not considered to be unintentional.

On 24 September 2001, applicant responded to the 24 May 2001 decision by filing the "Renewed Petition under CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 February 2002 because the delay was not considered to be unintentional.

On 10 June 2002, applicant responded to the 15 February 2002 decision by filing the "Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 November 2002 because the delay was not considered to be unintentional.

On 15 January 2003, applicant filed "Second Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b)." The petition was DENIED in a decision dated 04 June 2003 because the delay was not considered to be unintentional.

On 24 November 2003, applicant filed "Renewed Petition to Revive under 37 CFR 1.137(b)."

STATUTE AND REGULATION

35 U.S.C. § 41(a)(7) provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." Specifically, 35 U.S.C. § 41(a)(7) provides:

On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110.

37 CFR 1.137(b) provides:

Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;*
- (2) The petition fee as set forth in § 1.17(m);*
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and*
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.*

OPINION

Petitioner requests reconsideration of the decision dated 04 June 2003 and seeks to distinguish the facts of this case from the opinion and precedents cited therein in that, while Bradford Hospitals NHS Trust (the "Trust") deliberately permitted the instant international application to become abandoned as the United States, the widow of the deceased inventor, Mrs. Sabanathan, the purported true original owner of the subject patent application during the relevant period, did not intentionally abandon the application and, accordingly, revival should not be foreclosed.

The issue present here is whether the Trust's decision to intentionally abandon the subject application is binding upon Mrs. Sabanathan, the widow of the deceased inventor. It is noted that the facts of this case are quite unique. Although the Trust and Mrs. Sabanathan believed that they were partial owners of the patent application, Mrs. Sabanathan was the sole owner. The Trust, a non-owner, decided not to pursue the application and never informed the owner, Mrs. Sabanathan, of this decision. Mrs. Sabanathan had a right to expect that the Trust inform her of its decision not to file the application. As a result, neither Mrs. Sabanathan nor her legal representative participated in the decision not to pursue the application. Thus, Mrs. Sabanathan, the sole owner, never intended the application to go abandoned.

CONCLUSION

Therefore, the renewed request to revive the application abandoned under 37 CFR 1.137(b) is GRANTED as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration is required.



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